

REMARKS

A Restriction Requirement regarding the pending claims (1-3, 5, 6, 8-28 and 30-34) was mailed on August 8, 2006. The claims were restricted to:

- I. Claims 1-25, drawn to an alignment device.
- II. Claims 26-34, drawn to a method of manufacturing an alignment device.

Applicant elected Group I, with traverse, presented appropriate reasons, and requested reconsideration in a Response mailed on September 5, 2006. The Restriction Requirement was made final in an Office Action mailed on October 2, 2006. Applicant maintains that the Restriction is not proper under MPEP §806.05(f). Accordingly, the following Petition from Requirement for Restriction under 37 C.F.R. § 1.144 is presented.

In restricting between the device claims of Group I and the method of manufacture claims of Group II, the Restriction Requirement stated that “in the instant case, the product as claimed can be made by a materially different process, such as blow molding or extrusion.” In response to Applicant’s traversal, the Examiner further stated that “the plain meaning of the term ‘forming’ as used in some of the pending claims does not encompass the manufacturing method blow molding or extrusion for example.”

As explained in Applicant’s previous traversal of the Restriction Requirement, Applicant submits that the Examiner has erroneously misinterpreted the term “forming” as used in some of the pending claims. Without defining the term “forming” for the present purposes of determining whether the Restriction Requirement is proper, Applicant respectfully notes that during examination of a patent application, claims are to be given their broadest reasonable interpretation, consistent with the specification, pursuant to MPEP § 2111. There is no objective evidence anywhere in the present specification that the term “forming” was intended to exclude “blow molding” or “extrusion” or any other particular process of “forming.” Therefore, Applicant respectfully submits that the Examiner has arbitrarily adopted an unduly narrow definition of the term “forming” without providing any objective evidence of any basis for doing so.

The Restriction Requirement further asserted that Groups I-V represent patentably distinct species.

- I. Species I depicted in Figures 1A-1C, base unit having an insert material.
- II. Species II depicted in Figure 2, base unit having a standoff feature with a linear contact surface.
- III. Species III depicted in Figures 3A-3C, base unit having a standoff feature with a circular contact surface.
- IV. Species IV depicted in Figure 4, having an orienting fixture attached to the longitudinal guide portion.
- V. Species V depicted in Figure 5, having extending members attached to the longitudinal guide portion.

Applicant elected, with traverse, species III and claims 1-3, 5, 6, 9-12, 14-23 and 25. Among other things, Applicant traversed the statement that “currently no claim is generic” and explained that at least claim 1 is generic. However, the Examiner responded that claim 1 was not generic “because Figures 1A-C clearly show the base unit lacks the standoff features recited in claim 1.” However, Applicant respectfully submits that the claims themselves—not the figures—determine whether or not a claim is generic, and the Examiner has not provided any objective explanation for why the language of claim 1 is not generic.

Further, the MPEP requires that “Examiners must provide reasons and/or examples to support conclusions.” See MPEP § 803. In the present case, however, the Restriction Requirement fails to give any reasons or examples of what renders the asserted Groups I-V patentably distinct. Applicant respectfully submits that this amounts to arbitrary restriction by fiat, rather than providing any reasons as expressly required by the MPEP.

The MPEP also requires that, for purposes of the initial requirement, a serious burden on the Examiner may be *prima facie* shown “by appropriate explanation of separate classification, or separate status in the art, or a different field of search.” See *id.* Because the Restriction Requirement fails to even establish the basic characteristics upon which the restriction rests, it

also necessarily fails to provide any requisite explanation of separate classification, separate status in the art, or different field of search required to support the Examiner's *prima facie* burden. Therefore, Applicant respectfully submits that the Restriction Requirement has failed to establish any serious burden of searching and examining all of Groups I-V together. Accordingly, Applicant respectfully requests withdrawal of the restriction requirement and the required election of species and examination of all of claims 1-3, 5, 6, 8-28 and 30-34 together.

CONCLUSION

The kind consideration of the Office is truly appreciated in this matter. If necessary, please charge any petition fee to Deposit Account No. 19-0743.

Respectfully submitted,

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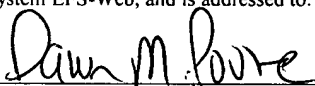
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 3rd day of January 2007.

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